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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803			EXAMINER AGWUMEZIE, CHARLES C	
			ART UNIT 3685	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/069,710

**Applicant(s)**

DEAKER ET AL.

**Examiner**

CHARLES C. AGWUMEZIE

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 43-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/00)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Paper No(s)/Mail Date 02/27/02

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 5, 2008 has been entered.

### **Acknowledgments**

2. Applicants' amendment filed on May 5, 2008 is acknowledged. Accordingly claims 43-78 remain pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claim 43**, is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

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5. Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup> If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.
6. In this particular case, claim 43 is neither (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.
7. Claims 42-69 are rejected under 35 U.S.C. §101 because of their dependency on claim 43.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claim 75** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

possession of the claimed invention. The examiner has reviewed the specification and has not been able to find in any part within the specification that would support the phrase "stored value instrument". Clarification and correction is required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 43, 71, 74 and 75** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,193,155 in view of Beach et al U.S. Patent No. 5,892,872.

12. As per **claim 43, 74 and 75**, Walker et al discloses a method of validating a goods/service voucher comprising:

generating random alphanumeric token information associated with the goods/service voucher, the token information being communicable via both computer and non-computer means to an end user, and storing the token information and voucher information in a database, wherein each goods/service voucher has associated

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stored voucher information and stored token information stored in the database (col. 5, lines 5-25; ...a gift certificate may be any instrument or token...);

receiving voucher information and token information corresponding to the goods/service voucher (col. 5, lines 5-25; ...gift certificate...; col. 11, lines 10-20; ...receiving the gift certificate and the security code...);

comparing the received voucher information and the received token information with the database (col. 10, lines 15-30; ...compares certificate with stored....; col. 11, lines 10-35; ...matches the stored security code associated with the certificate identifier....);

determining whether the received voucher information and the received token information matches the stored voucher information and the stored token information (col. 11, lines 10-35; ...matches the stored security code associated with the certificate identifier....); and

generating an output to a user indicating that the voucher is valid if the received voucher information and the received token information match the stored voucher information and the stored token information (see fig. 13; output message indicating denial of redemption....; col. 11, lines 20-35; ....transmits authorization code indicating that the transaction is approved or declined...);

wherein the voucher information and token information may be received by the database via any one of the plurality of pathways, including via computer and non-computer means (see fig. 13; ...transmitted via network...).

13. What Walker et al does not explicitly disclose is generating random alphanumeric token.

14. Beach et al discloses a random alphanumeric token (see abstract, which discloses that the authorization codes generated for inclusion with the value certificates are unique and seemingly random ... they are generated by taking non-random unique code, such as sequence code, and encrypting it to obtain seemingly random, but unique authorization codes; col. 1, lines 5-25, which discloses ..must be generated randomly...; col. 3, lines 50-65, which discloses method for assuring security of individually identifiable randomly numbered certificates...).

15. Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method wherein random alphanumeric token is generated in view of the teachings of Beach et al since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

16. As per claim 44, Walker further discloses a method, wherein the token information associated with the goods/services voucher is issued to a designated beneficiary over a computer network (see figs. 1, 8 and 9; col. 1, lines 45-55).

17. As per claim 45, Walker failed to explicitly disclose a method, wherein the goods/services voucher is issued to the designated beneficiary by electronic mail.

Beach discloses a method, wherein the goods/services voucher is issued to the designated beneficiary by electronic mail (col. 9, lines 15-20, mail-in certificate...).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein the goods/services voucher is issued to the designated beneficiary by electronic mail in view of the teachings of Beach et al since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

18. As per claim 46, Walker further discloses a method, comprising receiving a customer order for issuing of goods/services voucher to a designated beneficiary, before issuance of the goods/services voucher, and issuing the goods/services voucher for the designated beneficiary (col. 8, lines 35-50).

19. As per claim 47, Walker further discloses a method, wherein the customer order is received via a system web site (col. 2, line 60-col. 3, line 25).

20. As per claim 48, Walker failed to explicitly disclose a method wherein the customer order is received via a subscribing goods/services provider web site.



Beach discloses a method wherein the customer order is received via a subscribing goods/services provider web site (col. 5, line 65-col. 6, line 20).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein the customer order is received via a subscribing goods/services provider web site in view of the teachings of Beach et al since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. As per claim 49, Walker further discloses a method wherein the customer order is received via a portal web site servicing the plurality of subscribing goods/service providers (col. 5, lines 25-40, which discloses participating merchants).

22. As per claim 50, Walker further discloses a method wherein the customer order is received from a physical retailer location where the customer is in attendance (col. 1, lines 45-65; col. 5, lines 25-40).

23. As per claim 51, Walker further discloses a method, wherein the customer order is received over a computer network (see figs. 1, 8 and 9).

24. As per claim 52, Walker failed to explicitly disclose a method, wherein the customer is a provider of a promotion and wishes goods/services items to be issued to a plurality of designated beneficiaries and wherein receiving the order includes receiving order information from the customer designating details of the plurality of beneficiaries.

Beach discloses a method, wherein the customer is a provider of a promotion and wishes goods/services items to be issued to a plurality of designated beneficiaries and wherein receiving the order includes receiving order information from the customer designating details of the plurality of beneficiaries (col. 1, lines 5-25; col. 4, line 65-col. 5, line 5; col. 5, line 65-col. 6, line 20).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein the customer is a provider of a promotion and wishes goods/services items to be issued to a plurality of designated beneficiaries and wherein receiving the order includes receiving order information from the customer designating details of the plurality of beneficiaries in view of the teachings of Beach et al since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

25. As per claim 53, Walker further discloses a method, wherein the order information is received over a computer network as a data file (see figs. 1, 8 and 9).

26. As per claim 54, Walker further discloses a method, comprising the further step of receiving payment information from the customer and of carrying out a check to determine the validity of the payment information (see figs. 10 and 14).

27. As per claim 55, Walker further discloses a method, comprising receiving redemption information, the redemption information including the provided token, before redeeming the goods/services voucher (see fig. 14; col. 11, lines 10-35; ...matches the stored security code associated with the certificate identifier....).

28. As per claim 56, Walker failed to explicitly disclose a method, wherein the redemption information is received via interactive voice response.

Beach discloses a method, wherein the redemption information is received via interactive voice response (see fig. 3).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein the redemption information is received via interactive voice response in view of the teachings of Beach et al since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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29. As per **claim 57**, Walker further discloses a method, wherein the redemption information is received via a web interface (see figs. 1, 8 and 9).

30. As per **claim 58**, Walker further discloses a method, wherein the redemption information is received via an interface with an electronic funds transfer network utilized by a payment transaction system (see fig. 1, 9 and 13).

31. As per **claim 59**, Walker further discloses a method, wherein the redemption information is received from a goods/service provider physical location (fig. 13).

32. As per **claim 60**, Walker further discloses a method, wherein the redemption information is received from an on-line E Commerce system of a goods/services provider (see fig. 13).

33. As per **claim 64**, Walker further discloses a method, wherein the goods/services voucher is designated for redemption in exchange for goods/services of one of a plurality of available subscribing goods/services providers (col. 5, lines 25-40, which discloses participating merchants).

34. As per **claim 70**, Walker discloses a method, wherein the goods/services voucher is transmitted over a computer network to a beneficiary, and wherein the

goods/services voucher is redeemed by transmitting the voucher to an E Commerce web site (fig. 1).

35. As per **claim 77**, Walker further discloses a system, the system including a link to a bank computing system, wherein the bank system is arranged to advise the system via the link when to issue the value transfer instrument (see fig. 1).

36. As per **claim 78**, Walker further discloses a system, further including a link to a redeeming bank system, wherein upon redemption the redeeming bank is arranged to provide the claim code to the system via the link (see fig. 10B).

37. **Claims 65-69, 72-73**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,193,155 in view of Beach et al U.S. Patent No. 5,892,872 as applied to claim 43 above, and further in view of Scroggle et al U.S. Patent No. 6,014,634.

38. As per **claim 65**, both Walker and Beach failed to explicitly disclose a method, wherein a voucher image is generated and associated with the goods/services voucher, the voucher image being delivered to a beneficiary with the goods/services voucher.

Scroggle discloses a method, wherein a voucher image is generated and associated with the goods/services voucher, the voucher image being delivered to a beneficiary with the goods/services voucher (see abstract; col. 2, lines 55-65).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein a voucher image is generated and associated with the goods/services voucher, the voucher image being delivered to a beneficiary with the goods/services voucher in view of the teachings of Scroggle since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

39. As per claim 66, both Walker and Beach failed to explicitly disclose a method in accordance with claim 65, wherein a different image is associated with each of the plurality of available subscribing goods/services providers.

Scroggle discloses a method in accordance with claim 65, wherein a different image is associated with each of the plurality of available subscribing goods/services providers (col. 10, lines 25-60; col. 11, lines 10-45)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein a voucher image is generated and associated with the goods/services voucher, the voucher image being delivered to a beneficiary with the goods/services voucher in view of the teachings of Scroggle since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have

performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

40. As per claim 67, Walker further discloses a method, wherein the voucher image is produced from voucher image data stored in the system database (see fig. 2, certificate table; fig. 12).

41. As per claim 68 and 76, both Walker and Beach failed to explicitly disclose a method, wherein the voucher image is delivered to a designated beneficiary over a computer network.

Scroggle discloses a method, wherein the voucher image is delivered to a designated beneficiary over a computer network (col. 10, lines 25-60).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein a voucher image is generated and associated with the goods/services voucher, the voucher image being delivered to a beneficiary with the goods/services voucher in view of the teachings of Scroggle since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

42. As per **claim 69**, both Walker and Beach failed to explicitly disclose a method, wherein the voucher image is delivered as an e-mail attachment.

Scroggle discloses a method, wherein the voucher image is delivered as an e-mail attachment (see abstract).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein the voucher image is delivered as an e-mail attachment in view of the teachings of Scroggle since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

43. As per **claim 72**, both Walker and Beach failed to explicitly disclose a method of issuing the voucher, wherein the voucher is transmitted to a computing device of a beneficiary.

Scroggle discloses a method of issuing the voucher, wherein the voucher is transmitted to a computing device of a beneficiary (see abstract; Figs. 1,5, 10-13,15-18)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, of issuing the voucher, wherein the voucher is transmitted to a computing device of a beneficiary in view of the teachings of Scroggle since the claimed invention is merely a combination of old and known elements and in the combination each element merely



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would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

44. As per claim 73, Walker further discloses a method of redeeming of a goods/services voucher, comprising transmitting voucher information from an E Commerce web site to a redemption system (see fig. 1).

45. As per claim 61, both Walker and Beach failed to explicitly disclose a method, wherein a beneficiary has provided the information to the E Commerce system by way of entering or forwarding the information to the goods/services providers web site in exchange for goods/services

Scroggle discloses a method, wherein a beneficiary has provided the information to the E Commerce system by way of entering or forwarding the information to the goods/services providers web site in exchange for goods/services (see abstract).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein a beneficiary has provided the information to the E Commerce system by way of entering or forwarding the information to the goods/services providers web site in exchange for goods/services in view of the teachings of Scroggle since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of

ordinary skill in the art would have recognized that the results of the combination were predictable.

46. Claims 62-63, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,193,155 in view of Beach et al U.S. Patent No. 5,892,872 as applied to claim 43 above, and further in view of Jacoves et al U.S. Patent No. 6,741,968 B2.

47. As per claim 62, both Walker and Beach failed to explicitly disclose a method wherein the goods/services voucher is redeemed for only a portion of its value.

Jacoves discloses a method wherein the goods/services voucher is redeemed for only a portion of its value (see claims 1 and 28; col. 6, lines 30-65).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, wherein the goods/services voucher is redeemed for only a portion of its value in view of the teachings of Jacoves since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

48. As per **claim 63**, both Walker and Beach failed to explicitly disclose a method, comprising storing a remaining value of the partially redeemed goods/services voucher in the database for later redemption.

Jacoves discloses a method, comprising storing a remaining value of the partially redeemed goods/services voucher in the database for later redemption (see claims 1 and 28; col. 6, lines 30-65).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method, comprising storing a remaining value of the partially redeemed goods/services voucher in the database for later redemption in view of the teachings of Jacoves since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Laor U.S. Patent No. 5,584,448 is a document considered relevant to the claimed invention.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art ad are

applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/  
Primary Examiner, Art Unit 3685  
July 24, 2008

